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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,432	02/16/2001	Louis Gregoire	032326-105	7611

21839 7590 08/27/2004

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EXAMINER

MCARDLE, JOSEPH M

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,432

Applicant(s)

GREGOIRE, LOUIS

Examiner

Joseph McArdle

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2-16-2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040816.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-3, and 5-8 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 97/04412 by Thomas H. Williams hereinafter referred to as the Williams reference or Williams. In regards to claim 1, Williams discloses a design that pertains to a secure means for software distribution. Williams then goes on to disclose on page 7, lines 13-18 how software can be protected from copying by having the software delivered in two parts. Williams explains in the aforementioned location how the first part can be distributed in any manner, even publicly accessible manners. Williams further discloses in Fig. 1 and on page 6, lines 3-11 how the first part can be stored in the memory of a computer system.

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Williams then goes on to disclose on page 7, lines 16-33 that the second part of the software is placed in the memory of a hardware key (Williams describes the hardware key in Fig. 2 and on page 7, lines 3-10 and discloses how the hardware key is a separate entity with its own processor that is used to contain the secure subroutines of the second part of the software). Fig. 2 also depicts an interface between the computer containing the first part of the software and the hardware key containing the second part of the software for the purposes of communicating data back and forth between the computer and the hardware key. These disclosures by Williams meet the exact limitations set forth under claim 1, which call for splitting a program into public and secret parts wherein the public part is placed in the memory of a first processing means and the secret part is stored on a second processing means (hardware key) both capable of communicating with one another for the purposes of executing the software. Williams then discloses on page 8, lines 4-14 how the first and second parts of the software cooperate with each other to accomplish the intended function of the software. It is also disclosed in the aforementioned location how the first part can call the second part to retrieve data or results necessary to complete the function of the software. It is also disclosed in the same location that when the second part is called it operates entirely within the processor contained within the hardware key to produce the results needed by the first part and to send the results back over the interface to the first part of the software that is operating within the memory of the computer. Williams also discloses on page 6, lines 30-32 and in Figs. 1 and 2 that the hardware key can have chip cards attached or

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detached. These disclosures meet the remaining limitations set forth under claim 1 that call for connecting the two processing means together for the purpose of exchanging parameters/variables that can be used by the second processing means in the execution of a portion of the program and transmit the results of the execution back to the first processing means as well as allowing the second processing means to be a portable and detachable chip medium.

4. In regards to claim 2, Williams discloses a design that pertains to a secure means for software distribution. Williams then goes on to disclose on page 7, lines 13-18 how software can be protected from copying by having the software delivered in two parts. Williams explains in the aforementioned location how the first part can be distributed in any manner, even publicly accessible manners. Williams further discloses in Fig. 1 and on page 6, lines 3-11 how the first part can be stored in the memory of a computer system. Williams then goes on to disclose on page 7, lines 16-33 that the second part of the software is placed in the memory of a hardware key (Williams describes the hardware key in Fig. 2 and on page 7, lines 3-10 and discloses how the hardware key is a separate entity with its own processor that is used to contain the secure subroutines of the second part of the software). Fig. 2 also depicts an interface between the computer containing the first part of the software and the hardware key containing the second part of the software for the purposes of communicating data back and forth between the computer and the hardware key. These disclosures by Williams meet the exact limitations set forth under claim 2, which call for splitting a program into public and secret parts wherein the public part is

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placed in the memory of a first processing means and the secret part is stored on a second processing means (hardware key) both capable of communicating with one another for the purposes of executing the software. In regards to the 2nd and 3rd limitations set forth under claim 2, Williams discloses on page 8, lines 19-24 how the secure subroutines (or second software portion) are encoded and must be decoded in order to be used with the application software. Williams further discloses on page 10, lines 7-8 and in Fig. 5 how the hardware key (second processor) decodes the secure parts of the software so that they can be transferred to and from the first processor. These disclosures by Williams meet the limitations set forth under claim 2 that call for encoding a secret part and placing it on the same medium as the public part and for also placing a decoding function on the second processor (see page 10, lines 7-8 and Fig 5.). Williams then discloses on page 8, lines 4-14 how the first and second parts of the software cooperate with each other to accomplish the intended function of the software. It is also disclosed in the aforementioned location how the first part can call the second part to retrieve data or results necessary to complete the function of the software. It is also disclosed in the same location that when the second part is called it operates entirely within the processor contained within the hardware key to produce the results needed by the first part and to send the results back over the interface to the first part of the software that is operating within the memory of the computer. Williams also discloses on page 6, lines 30-32 and in Figs. 1 and 2 that the hardware key can have chip cards attached or detached. These disclosures meet the remaining limitations set forth under claim

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2 that call for connecting the two processing means together for the purpose of exchanging parameters/variables that can be used by the second processing means in the execution of a portion of the program and transmit the results of the execution back to the first processing means as well as allowing the second processing means to be a portable and detachable chip medium.

5. In regards to claim 3, Williams discloses on page 9, lines 19-24 that a request is sent for the secure subroutines (that is the second, secure part of the program) that are not contained within the first software part. This disclosure meets the limitations set forth under claim 3 that call for transmitting a portion of the encoded program according to the extent needed and/or as a function of the capacity of the second, secure processing means because in the Williams reference portions of the encoded program are only decoded for use and for transmission as requested (i.e. as needed).

6. In regards to claim 6, Williams discloses in Fig. 1 and on page 6, lines 3-11 a processor that controls the operation of the computer system. This disclosure meets the exact limitations set forth under claim 6.

7. In regards to claims 7 and 8, Williams discloses in Fig. 1 how the processor is connected to a network. Williams also discloses on page 4, lines 31-32 through page 5, lines 1-2 that as long as a user is an active subscriber they will be able to gain access to portions of the software. Williams further discloses on page 8, lines 29-31 that a server device is used in transferring the software between computer systems. These disclosures meet the exact limitations set forth under claims 7 and 8.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Le Roux (U.S. Patent No. 6182205). In regards to claims 4 and 5, Williams's design disclosed above meets all of the aforementioned limitations set forth under claim 1. However, Williams's design makes no specific mention of allowing the second processing means to be a card containing a microprocessor or wherein the second processing means is in a hardwired form on a memory card. Le Roux teaches in column 1, lines 17-32 how PC cards can be employed for the purposes of storing programs. Le Roux then discloses in column 3, lines 22-33 that the PC card can contain a processor or microprocessor that serves to operate on the programs stored on the card. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Le Roux's teachings and disclosures relating to the use of a PC card with a processor into Williams design in order to achieve a design that is capable of allowing the second processing means to be a card having a microprocessor and to be in a hardwired form on a memory card.

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Allowable Subject Matter

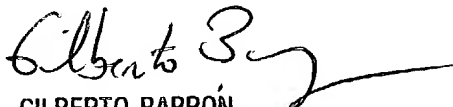
10. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph McArdle whose telephone number is (703) 305-7515. The examiner can normally be reached on Weekdays from 8:00 am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100


Joseph McArdle
Examiner

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jmm